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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/972,448 | 10/06/2001 | Koya Suzuki | 5000-4960 | 4076 |

7590 11/05/2003
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154

EXAMINER

GARCIA, ERNESTO

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3679

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,448

Applicant(s)

SUZUKI ET AL.

Examiner

Ernesto Garcia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 4,11,13 and 17-20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,5-7,14 and 15 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 8-10 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

The allowability of claim 2, now claim 1, is withdrawn in view of Japanese patent, JP-2000-120649. Rejections based on the reference follow.

Election/Restrictions

Claims 4, 11, 13 and 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 10/2/03 was filed after the mailing date of the final Office action on 06/25/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

Formal drawings were received on 9/23/03. These drawings are not acceptable as reference 108s was not included in Figure 5 as proposed on the drawing corrections filed on 9/23/03.

Claim Objections

Claim 3 is objected to because of the following informalities:

regarding claim 3, it is unclear whether "an outer diameter of the step portion" in line 5 is the same diameter of the step portion as recited in line 9 of claim 1; for purposes of examination the examiner has considered the outer diameter of claim 9 to be the same diameter recited in claim 1; it is also unclear whether "an inner diameter of the pressure insertion portion" in line 5 is the same diameter of the pressure insertion portion as recited in line 9 of claim 1; furthermore, it is unclear whether "an outer diameter of the serration portion" in line 6 is the same diameter of the serration portion as defined in line 10 of claim 1. For purposes of examination, the examiner has considered the diameters of claim 3 to be the same diameters of claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3, 5-7, 14 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Japanese publication, JP2000-120649A by Yasuchika et al. (see marked-up attachment).

Regarding claim 1, Yasuchika et al. disclose in Figures 7 and 8 a first member **3**, and second member **2**. The first member **3** has a serration portion **7b** provided at a pressure insertion end portion **A3** of the first member **3**. The second member **2** has a pressure insertion portion **A5**. The first member **3** has a surface contact portion **A6** at location adjacent to the serration portion **7b**. The surface contact portion **A6** includes a step portion **A7** provided between a leading end portion **A8** of the pressure insertion end portion **A3** and the serration portion **7b**. A diameter **A9** of the step portion **A7** is set between a diameter **A10** of the pressure insertion portion **A5** and a diameter **A11** of the serration portion **7b**. The first member **3** is a metal yoke of a propeller shaft and the second member **2** is a fiberglass reinforced plastic cylinder of the propeller shaft (see English abstract).

Regarding claim 3, the serration portion **7b** is provided to an outer circumferential surface of the pressure insertion end portion **A3**.

Regarding claim 5, the first member **3** is a metal member; and the second member **2** is a resin member (see abstract).

Regarding claim 6, after the second member **2** is joined to the serration portion **7b**, the step portion **A7** is in non-contact with the second member **2**.

Regarding claim 7, the first member **3** has a chamfering portion **3b** extended from the leading end portion **A8** to the step portion **A7**.

Regarding claim 14, applicant is reminded that the method of forming the step portion is not germane to the issue of patentability of the device itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113.

Regarding claim 15, the step portion **A7** is formed cylindrically between the leading end portion **A8** and the serration portion **7b**.

Allowable Subject Matter

Claims 8-10 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claims 8 and 9, the prior art of record does not disclose or suggest a joining structure comprising a step portion connected to a serration portion through an inclined surface; there is no motivation to place an inclined surface on the Japanese patent;

regarding claims 10 and 12, these claims depend from claim 9.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone

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numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



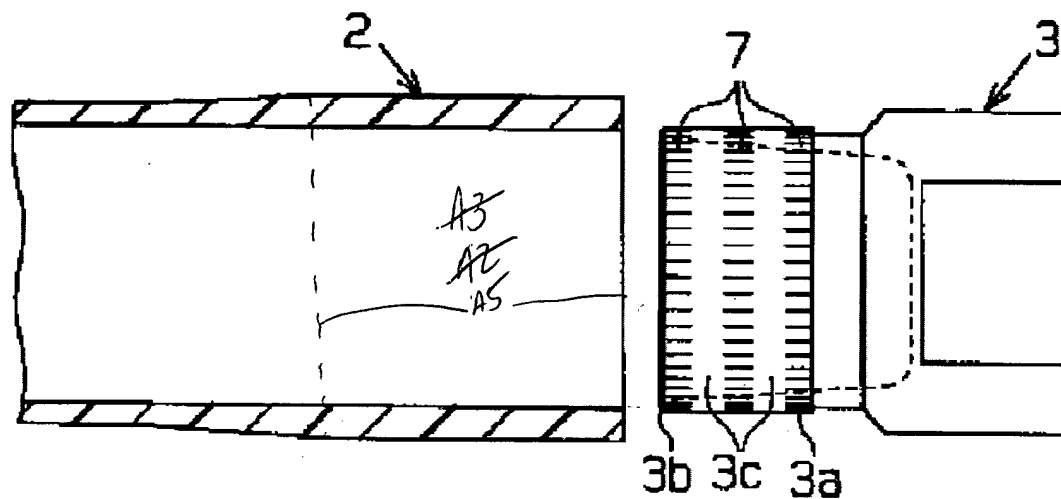
Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3600

E.G.

October 28, 2003

Attachment: one marked-up copy of Japanese publication, JP-2000-120649

【図7】



【図8】

